

REMARKS

Reconsideration of the above-referenced application is respectively requested in view of the above amendments and these remarks. Claims 1-3, 5-20 and 25-33 are currently pending. Claims 4 and 21-24 have been cancelled.

In the Office Action, claims 8-11, 15-20 and 31-33 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant notes with appreciation that the subject matter of these claims is deemed to be allowable if rewritten to include all limitations of the superseding and rejected claims. Applicant wishes to reserve the right to rewrite these claims, should further discussions regarding the base and superseding claims prove unrewarding.

Claims 1-20 and 25-33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. In response to the corrections requested, Applicants have amended the claims to delete references to “arranged,” “operable,” “configured” and “configured.” Applicants have also corrected noted typographical errors as well as inserted correct terms for “first communication network” and “wireless communication unit.” Claims 20-24 have been cancelled as required. In view of these amendments, Applicants request that the rejections under Section 112, second paragraph, be withdrawn.

In the Office Action, claims 1-2, 12-13 and 25-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,138,030 to Coombes et al. in view of United States Patent Application Publication No. 2003/0134638 to Sundar et al. Applicants have carefully reviewed the cited art and the arguments presented in the Office Action and respectfully traverse the rejection. In particular, Applicants respectfully submits that the cited combination fails to disclose handing over a call where that call is placed on hold prior to the call being handed over as required by independent claims 1, 11 and 25.

Applicants note that a full description of the present invention as well as the differences between the present invention and Coombes have been made previously. Those descriptions and arguments are incorporated here. In the Office Action, it is acknowledged that Coombes does not disclose “the on-hold call is established in the first communication network and handed over to become an on-hold call in the second communication network and that is done using a call leg in the second communication network where the first communication network is . . . a WLAN and the second communication network is a WWAN and vice versa.” Sundar is cited, however, for this proposition with references to paragraphs [0028] and [0098]-[0099]. Applicant notes that paragraph [0028] refers to the Sundar’s drawings. Applicants review of those drawings fails to reveal any disclosure that a call is placed on hold and in particular that the call is placed on hold before a hand over is determined necessary, as required by the claims.

Applicants also assert that paragraphs [0098]-[0099] if Sundar do not discuss an on-hold call that is created prior to determining that a handout from a WWAN to a WLAN or vice versa is desired and thereafter retrieve the on-hold call from the first communication network while the wireless communication network is operating in the second communication network via a call leg in the second communication network established for coupling the on-hold call to the wireless communication unit. These paragraphs describe an “embodiment of a method that may be used to affect handoffs in the absence of such connectivity. . . . [T]he mobile station 310 (MS) while engaged in a telephone call with Party A . . . senses both the WLAN and the WWAN environments and determines that the WLAN environment is waning in intensity whereas the WWAN environment is gaining in intensity. Under such an arrangement mobile station 310 may determine that a handoff is imminent.” Applicant notes here that the call is on-going, i.e. mobile station is engaged in a telephone call, when the determination is made that a handoff is imminent. This is specifically contrary to what is required by the claims. Sundar goes on to say that “[u]pon making this determination [that the handoff is imminent while the mobile station is engaged in the telephone call] mobile station 310 requests 3004 the WLAN switch 302 to issue a Temporary Local Directory Number (TLDN). As is well known to a practitioner in the art a TLDN may be used by other telephone exchanges to route a call to the switch issuing the TLDN.” Applicants note

here that the TLDN is used to the route the call, which is referred to here as the mobile station being engaged in a telephone call. The TLDN is not referenced to an on-hold call.

Sundar continues “[H]aving received the TLDN the mobile station 310 continues roaming and the mobile station 310 or the WLAN switch or both may find 3006 that the connectivity between the mobile station 310 and the WLAN switch has been lost. In such an eventually the WLAN switch temporarily places 3008 party A on hold.” This is the first reference that there is a call on hold. Applicant notes that the call is placed on hold after the handoff is determined to be occurring and only because the connection to the WLAN switch is lost. The next sentence continues with the handoff procedure: “The mobile station 310 upon sensing the WWAN environment and upon successful completion of registration in the WWAN environment, request a call to be placed using the TLDN as the destination (called party). The WWAN switch routes 3010 the call to the WLAN switch using its routing logic dependent on the TLDN. The WLAN switch recognizes 3012 the TLDN and connects Party Q to the incoming call. Thus, Party A and the MS resume the on going call albeit with an interruption.” Paragraph [0099] does not provide any additional details to the described procedure.

As stated, Applicant notes that Sundar, link Coombes and Buttitta, does not disclose that the handoff is for an on-hold call. Sundar, like Coombes and Buttitta, discloses that the call is put on hold as a part of the handoff procedure. Specifically Sundar states that the handoff is imminent and that the signal of the WLAN is waning and the WWAN is strengthening before any discussion that the call is placed on hold. Applicants also note that references to Paragraphs [0070]-[0073] do not produce any more teaching about transferring an on-hold call.

In view of the foregoing, Applicants respectfully submit claims 1, 12 and 25 are patentable over the combination of Coombes and Sundar. Applicants therefore respectfully request that the rejection under Section 103(a) be withdrawn. As claims 2, 13 and 26 depended upon allowable claims 1, 12, and 25, Applicants also request that the rejection under Section 103(a) to these claims be withdrawn.

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Coombes in view of Sundar as applied to claim 1 and further in view of United States Patent No. 7,215,759 to Brown et al. As claim 3 depends on claim 1, Applicants arguments

regarding Coombes and Sundar are repeated here. Brown discloses multiple held calls are in a hold queue. Brown teaches the publishing of hold queue information to a caller. In particular, hold queue information may include real-time information about call hold times, current call duration times, current call queue positions, current number and identity of representatives available, estimated wait times, estimated time per call, estimated time per subject of call, etc. Brown extensively discusses the identification of a caller instead of the identification of a call. A phone number used when a call is initially established is used to retrieve a profile for the caller. Brown does not teach a controller that “distinguished the call from other calls within the second communication network by comparing call information to expected call information.”

Brown neither discloses, teaches nor otherwise suggests a controller that is part of a wireless communication unit, a call in a second communication network, and the existence of expected call information. Moreover, the calls in Brown are not retrieved while operating in a network that is different from the network in which the call was put on hold. For these reasons and for the reasons given above to distinguish claim 1 from Coombes and Sundar, Applicants respectfully submit that claim 3 is patentable over the cited combination of Coombes, Sundar and Brown.

Claims 4-7, 14, 27 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coombes in view of Sundar as applied to claims 1, 12 and 25 and further in view of United States Patent No. 6,633,635 B2 to Kung et al. As stated above, Applicants have amended independent claims 1, 12, and 25 upon which claims 4-7, 14 and 27 and 30 depend, respectively. Thus, each and every limitation of independent claims 1, 12 and 25, including the limitation that a call is placed on hold prior to the determination that a hand out is required, are a part of these rejected claims. Kung has been discussed in full before, and Applicants discussion relating to these claims and Kung are incorporated here.

It is therefore respectfully submitted that the combination of Coombes, Sundar and Kung does not disclose, teach, discuss or otherwise suggest what is claimed in claims 4-7, 14, 27 and 30. Applicants therefore respectfully submit that these dependent claims are patentable and non-obvious over Buttitta in view of Kung. Applicants request that this rejection under Section 103(a) be withdrawn.

In the Office Action, claims 19 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coombes and Buttitta as applied to claims 12-13 and 25-26 and further in view of well known prior art. Applicants have amended independent claims 12 and 25 upon which claims 19 and 32 depend, respectively. Thus, each and every limitation of independent claims 12 and 25 are included in these rejected claims. The known prior art cited in the Office Action does not disclose, teach, discuss or otherwise suggest the claimed network, the on call leg being on the second communication network and the on-hold call being in the second communication network. For these reasons and those given above, Applicants therefore respectfully submit that claims 19 and 32 are patentable and non-obvious over the cited combination. Applicants request that this rejection under Section 103(a) be withdrawn.

Claims 20 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coombes in view of Buttitta as applied to claims 12-13 and 25-26 above in view of well known prior art as applied in claims 19 and 32, and further in view of Kung. Applicants have amended independent claims 12 and 25 upon which claims 20 and 33 depend, respectively. Thus, each and every limitation of independent claims 12 and 25 are included in these rejected claims. For these reasons and the reasons explained above with respect to the other claims, Applicants respectfully submit that claims 20 and 33 are patentable and non-obvious over the cited combination. Applicants request that this rejection under Section 103(a) be withdrawn.

As the Applicants have overcome all substantive rejections and objections given by the Examiner and have complied with all requests properly presented by the Examiner, the Applicants contend that this Amendment, with the above discussion, overcomes the Examiner's objections to and rejections of the pending claims. Therefore, the Applicants respectfully solicit allowance of the application. If the Examiner is of the opinion that any issues regarding the status of the claims remain after this response, the Examiner is invited to contact the undersigned representative to expedite resolution of the matter.

Serial No. 10/725,661
Segal et al
Case No. CE12199N

Please charge any fees associated herewith, including extension of time fees, to
50-2117.

Respectfully submitted,
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